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MATTISON, LORI K				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/525,637

Applicant(s)

LEBOK ET AL.

Examiner

LORI MATTISON

Art Unit

1619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36-62 and 64-75 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36-62 and 64-75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Applicant should note that the examiner for this case has changed.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on 10/15/2008 has been entered.

Status of Claims

Applicant's amendments filed 09/08/2008 to claims 36-62 and 64-75 have been entered. Claims 63 and 76 have been cancelled. Claims 36-62 and 64-75 remain pending in the current application, of which claims 36-62 and 64-75 are being considered on their merits. Any rejections of record not particularly addressed below are withdrawn in light of the claim amendments and applicant's comments.

Claim Objections

Claim 40 is objected to because of the following informalities: the scientific names are not properly formatted, e.g. *Rhus succedanea*.

Claim 64 is objected to because of the following informalities: there is a grammatical error in the claim: "as preserving a agent..." Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 36-62 and 64-75 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "vegetable-based" in claims 36 and 64 is a term which renders the claim indefinite. It is unclear what is meant by "vegetable-based." It is unclear whether vegetable-based excludes oil from animals but permits inclusion of synthetic oils. It is unclear whether blends of tallow (animal fat) and vegetable oils are vegetable-based. It is unclear whether blends of synthetic oils and vegetable oils are vegetable-based. In sum, it is not clear how closely related to a vegetable an oil must be to be considered "vegetable-based." Clarification is required. Because claims 37-62 and 64-75 depend from indefinite claim 36 and do not clarify the point of confusion, they must also be rejected under 35 U.S.C. 112, second paragraph.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 1619

Claims 36, 37, 40-42, 44, 45, 51, 54, and 55 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 3,937,811 (Papantoniou, 1976).

Example III (Col 10, lines 30-55) of Papantoniou discloses a lip polish (i.e. make up). This lip polish comprises a lipid component (Fatty composition C). Fatty composition C comprises the vegetable oil phases of candellila wax, carnauba wax, and ricin oil (Col 10, lines 30-55); these reagents comprise 1.9%, 1.9%, and 37% by weight, of the composition respectively. Thus the content of the vegetable oils is 37% (reading on instant claims 41, 44) and the content of the vegetable waxes is 3.8%. The composition comprises a solid phase which comprises the aluminum lake of the organic pigment FD&C Yellow No.5. and Zirconium lake of the organic pigment D and C red No 21. The solid phase comprises 2% of the composition by weight.

Claims 36-38, 51, 53, 56, 57 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 4,437,895 (Koulbanis, 1984).

Example 10 of Koulbanis teaches a lipstick composition (Col. 5 lines 60-end; Col. 6 lines 1-5). The composition comprises a solid phase which comprises the organic and inorganic pigments of red iron oxide, yellow iron oxide, DC Red 7 (calcium salt), DC Yellow 6 (aluminum salt) and DC Red 36 in an amount of 1%, 1%, 2%, 2%, and 1.5% by weight respectively. Thus, the pigments comprise 7.5% of the composition. The composition comprises the lipid phase of Example 7 (Col. 5 lines 20-40), which comprises an oil phase

Art Unit: 1619

which is a mixture of jojoba oil and mango oil. The lipstick composition comprises this oil mixture in an amount of 13.5% by weight.

Example 11 of Koulbanis teaches a rouge (i.e. makeup)(Col. 6 lines 5-30). The composition comprises a solid phase which comprises the organic and inorganic pigments of silicates with a high magnesium content, titanium dioxide, iron oxides, titanium mica, and DC Red 7 (calcium lake) in an amount of 2%, 1%, 2%, 5%, and 0.3% by weight respectively. Thus, the pigments comprise 10.3% of the composition. The composition also comprises a mixture of vegetable oils (i.e. an oil phase) which contains mango oil and jojoba oil. This oil phase comprises 20% of the composition.

Claims 36, 37, and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 4,360,387 (Brown, 1982).

Example 1 of Brown (Col. 4 lines 50-65) teaches a composition which comprises castor oil and JOJOBUTTER (i.e. an oil phase). Brown teaches that JOJOBUTTER is a tradename for the isomerate and hydrogenate of jojoba oil in an isomorphous mixture (Col. 4, lines 20-35). The composition comprises beeswax (i.e. solid phase).

Claims 36, 37, 41, 42, 44, 45, 51, 53, 54 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 6,355,261 (Bonda, 2002)

Example III of Bonda (Col. 16) teaches a lipstick composition which comprises an oil phase castor oil present in an amount of 41% which is present

Art Unit: 1619

in a fatty phase. Vegetable waxes (Candellila and carnauba) are also present as an oil phase, comprising 7% of the composition by weight. The composition comprises a solid phase which contains pigments and a barium lake. The combined amount of the pigments are 3.0% of the composition. The composition also comprises mica.

Claims 36 and 73 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 6,277,182 (Lebok, 2001).

Example III of Lebok teaches a lipliner (Col. 6, lines 1-25). The lipliner comprises a vegetable oil phase of castor oil and hydrogenated vegetable oil. A solid phase is also present. The composition comprises pigment. The lip liner material was cast into molds and cooked to produce shaped leads (i.e. stick). These leads were placed into the sleeve banks and further processed to produce a pencil.

Claims 36 and 69 are rejected under 35 U.S.C. 102(b) as being anticipated by UK Patent Application GB 2084084 (Morane, 1981).

Example III (page 4, lines 25-55) of Morane teaches a composition against rings under the eyes (i.e. a makeup). This composition comprises a vegetable oil phase comprising carnauba wax and a solid phase comprising of iron oxide. The composition is disclosed as being cased into a pencil corresponding to the Figure I which is the first embodiment. This first form is a sheath made of plastic (page

Art Unit: 1619

1, lines 30-45). Morane teaches that the composition is cast right into the sleeve (page 1, lines 50-60).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 36, 37, 43, 46, 47-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,086,859 (Calello, 2000) in view US Patent No. 5683972 (Zocchi, 1997), Minorsky as published in *Plant Physiology* in 2000, and Beauty Care.com <http://www.beautycare.com/cgi-bin/trends/viewnews.cgi?newsid945548222,2469>, archived February 2000, accessed 1/27/2009.

Calello teaches a pigmented lipstick composition. The composition comprises 1-25% pigment (i.e. solid phase), 0.01-30% skin protectant, 5-80% of a selected from volatile and nonvolatile oils (i.e. an oil phase) and 3-40% of a wax (i.e. an oil phase) with a melting point of 30-135 °C (abstract). Calello

Art Unit: 1619

teaches that the oil may be naturally occurring and derived from a vegetable source. Castor oil is specifically taught as a suitable oil (Col. 3, lines 45-60). Calello specifically teaches that hydrogenated jojoba oil may be used as the wax in the composition (Col.4, lines 55-end). Calello hints about the importance of meadowfoam seed oil for use in his composition by teaching a carboxylic acid wherein the substituent is selected to provide an ingredient known as meadowfoam seed oil (Col. 4, lines 25-45).

However, Calello does not teach use of meadowfoam seed oil in the composition.

Minorsky teaches that meadowfoam seed oil comprises a high percentage of eicosenoic acid that is more stable to oxidation, a property that makes it especially desirable for use in cosmetics (page 1, Column 3, last paragraph).

Zocchi teaches that meadowfoam seed oil and castor oil are equivalents that are responsible for providing skin conditioning and feel to compositions (Col. 2, lines 45-65).

Beautycare.com teaches that it is the amount of wax in a lipstick that helps it glide on to the lips. The wax may also help to moisturize dry lips (paragraph 3, page 1).

A person of ordinary skill in the art would have had a reasonable expectation of success in substituting meadowfoam seed oil for castor oil in the composition taught by Calello because meadowfoam seed oil is an equivalent for castor oil as taught by Zocchi. The skilled artisan would have been motivated to

Art Unit: 1619

do so because meadowfoam seed oil is more stable to oxidation as taught by Minorsky.

It therefore would have been obvious to a person of ordinary skill in the art at the time the invention was made to have substituted meadowfoam seed oil for castor oil in the composition of Calello because meadowfoam seed oil is an oxidation stable equivalent of castor oil as taught by Minorsky and Zocchi.

With regard to the weight percentages of meadowfoam seed oil and hydrogenated jojoba oil in recited instant claims 48 and 49, the selection of 2-35% and 5-25% weight percent of hydrogenated jojoba oil and meadowfoam seed oil would have been a routine matter of optimization on the part of the artisan of ordinary skill, said artisan recognizing that meadowfoam seed oil is an oil and oils are taught by Calello to comprise from 5-80% of the composition, while waxes, such as hydrogenated jojoba oil, are taught by Calello to comprise 3-40% of the composition, said artisan recognizing that optimizing the amount of meadowfoam seed oil impacts the conditioning properties of the composition as taught by Zocchi and optimizing the amount of wax impacts the moisturizing and application properties of the composition as taught by Beautycare.com. A holding of obviousness over the cited claims is therefore clearly required.

With regard to the ratio of hydrogenated jojoba oil and meadowfoam seed oil (instant claim 50), the selection of 1:2 to 2:1 ratio of hydrogenated jojoba oil to meadowfoam seed oil would have been a routine matter of optimization on the part of the artisan of ordinary skill, said artisan recognizing that meadowfoam seed oil is an oil which may comprise from 5-80% of the composition and

Art Unit: 1619

hydrogenated jojoba oil a wax which may comprise 3-40% of the composition as taught by Calello, said artisan recognizing that optimizing the ratio of meadowfoam seed oil to the hydrogenated jojoba oil optimizes the conditioning and application properties of the composition as taught by Beautycare.com. A holding of obviousness over the cited claims is therefore clearly required.

Therefore, the invention as a whole would have been prima facie obvious to a person of ordinary skill at the time the invention was made.

Claims 36-38, 51-53, 56, and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 4,437,895 (Koulbanis, 1984).

Example 10 of Koulbanis teaches a lipstick composition (Col. 5 lines 60-end; Col. 6 lines 1-5). The composition comprises a solid phase which comprises the organic and inorganic pigments of red iron oxide, yellow iron oxide, DC Red 7 (calcium salt), DC Yellow 6 (aluminum salt) and DC Red 36 in an amount of 1%, 1%, 2%, 2%, and 1.5% by weight respectively. Thus, the pigments comprise 7.5% of the composition. The composition comprises the lipid phase of Example 7 (Col. 5 lines 20-40), which comprises an oil phase which is a mixture of jojoba oil and mango oil. The lipstick composition comprises this oil mixture in an amount of 13.5% by weight.

Example 11 of Koulbanis discloses a rouge (i.e. makeup)(Col. 6 lines 5-30). The composition comprises a solid phase which comprises the organic and inorganic pigments of silicates with a high magnesium content, titanium dioxide, iron oxides, titanium mica, and DC Red 7 (calcium lake) in an amount of 2%, 1%,

Art Unit: 1619

2%, 5%, and 0.3% by weight respectively. Thus, the pigments comprise 10.3% of the composition. The composition of Example 11 also comprises a mixture of vegetable oils (i.e. an oil phase) which contains mango oil and jojoba oil. The oil phase of Example 11 comprises 20% of the composition. Koulbanis teaches that fillers such as talc and kaolin may also be included in the composition (Col.3, lines 45-55).

Koulbanis does not embody use of the fillers talc or kaolin in Example 11.

A person of ordinary skill in the art would have had a reasonable expectation of success in optimizing the composition taught by Koulbanis through routine experimentation by adding the fillers, talc or kaolin because Koulbanis teaches that these filler substances may be added to the composition. The skilled artisan would have been motivated to do so because Koulbanis provides an invitation to optimize the composition by routine experimentation by explicitly teaching that composition may contain these substances.

It therefore would have been obvious to a person of ordinary skill in the art at the time the invention was made to optimize the composition taught by Koulbanis through routine experimentation by adding the filler substances, kaolin or talcum (i.e. talc) to the composition because Koulbanis teaches that these fillers may be in the composition and provides an invitation to optimize his invention.

Therefore, the invention as a whole would have been prima facie obvious to a person of ordinary skill at the time the invention was made.

Claims 36, 37, 40-42, 44, 45, 51, 53-55, and 58-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 3,937,811 (Papantoniou, 1976) in view of US Patent No. 5,690,915 (Eteve, 1997).

Example III (Col 10, lines 30-55) of Papantoniou teaches a lip polish (i.e. make up). This lip polish comprises a lipid component (Fatty composition C). Fatty composition C comprises the vegetable oil phases of candellila wax, carnauba wax, and ricin oil (Col 10, lines 30-55); these reagents comprise 1.9%, 1.9%, and 37% by weight, of the composition respectively. Thus the content of the vegetable oils is 37% (reading on instant claims 41, 44) and the content of the vegetable waxes is 3.8%. The composition comprises a solid phase which comprises the aluminum lake of the organic pigment FD&C Yellow No.5. and a zirconium lake of the organic pigment D and C red No 21. The solid phase comprises 2% of the composition by weight. Papantoniou teaches use of inorganic pigments, such as titanium oxide, such as in the lip rouge of Example II (Col. 9, lines 50-end). Papantoniou teaches that inorganic pigments such as oxides of metals like iron and chromium may be employed in amounts of about 1 to 6% of the composition (Col. 5 lines 60-end; Col.6, lines 1-5). Use of anti-solar agents is also taught by Papantoniou (Col.5, lines 55-60).

However Papantoniou does not teach the size of the pigment.

Eteve teaches that the titanium oxide can protect against ultraviolet light, however when the concentration of titanium oxide is increased in a composition the composition becomes more difficult to apply (Col. 1, lines 35-55). The nanopigments taught by Eteve have a mean diameter preferably between 5 and

Art Unit: 1619

50 nm (Col. 2, lines 35-55). The nanopigment may be titanium oxides (Col. 2, lines 35-55). These nanopigments are taught to have improved cosmetic properties while providing protection against UV-A and UV-B (Col.1 lines 55-end; Col. 2 lines 1-15), making it possible to prevent photodermatoses (Col. 2 lines 1-15).

A person of ordinary skill in the art would have had a reasonable expectation of success in optimizing the composition taught by Papantoniou by substituting the titanium oxide of Papantoniou with the titanium oxide nanopigments (average size 5-50 nm) taught by Eteve because Eteve's titanium oxide pigments have improved cosmetic properties as taught by Eteve. The skilled artisan would have been motivated to do so because Eteve teaches that these nanopigments provide protection against UV-A and UV-B.

It therefore would have been obvious to a person of ordinary skill in the art at the time the invention was made to substitute the titanium oxide of Papantoniou with the titanium oxide nanopigments (average size 5-50 nm) taught by Eteve because Eteve's titanium oxide pigments have improved cosmetic and protective properties.

A person of ordinary skill in the art would have had a reasonable expectation of success in optimizing the composition taught by Papantoniou by substituting the titanium oxide of Papantoniou with the titanium oxide nanopigments of Eteve in an amount of between 1-6% by weight because Papantoniou teaches that metal oxide pigments may be used in this amount in his compositions. The skilled artisan would have been motivated to do so

Art Unit: 1619

because Eteve's titanium oxide nanopigments provide protection against UV-A and UV-B as taught by Eteve and Papantoniou teaches use of anti-solar agents in his composition.

It therefore would have been obvious to a person of ordinary skill in the art at the time the invention was made to substitute the titanium oxide of Papantoniou with the titanium oxide nanopigments of Eteve in an amount of between 1-6% by weight because Papantoniou teaches that metal oxide pigments.

Therefore, the invention as a whole would have been prima facie obvious to a person of ordinary skill at the time the invention was made.

Claims 61 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Papantoniou and Eteve as applied to claims 36, 37, 40-42, 44, 45, 51, 53-55, and 58-60 above, and further in view of US Patent No. 5,605,679 (Hansenne, 1997).

The teachings of Papantoniou and Eteve are relied upon as above. Furthermore, Papantoniou teaches inclusion and embodies use of anti-solar agents in his lip compositions (Col.5, lines 55-60; Example 1, Col. 9 lines 25-55).

Papantoniou does not teach whether the anti-solar agents are oil soluble, nor does Papantoniou teach use of 4-methylbenzlidene camphor.

Hansenne teaches that 4-methylbenzlidene camphor is a lipophilic (Col. 2, lines 30-45) sunscreen compound which is highly active in the UV-B range (Col.

Art Unit: 1619

2, lines 5-25). Hansenne teaches that 4-methylbenzlidene camphor may be used in makeup compositions such as lipstick (Col.6, lines 30-40).

A person of ordinary skill in the art would have had a reasonable expectation of success in improving the composition by adding the oil soluble UV-B sunscreen compound, 4-methylbenzlidene camphor to Papantoniou's composition because Papantoniou teaches inclusion of anti-solar (i.e. sunscreen agents) in his composition and even included anti-solar agents in lip rouge (i.e. lipstick/makeup). The skilled artisan would have been motivated to do so because 4-methylbenzlidene camphor is taught to be used in makeup compositions such as lipstick.

It therefore would have been obvious to a person of ordinary skill in the art at the time the invention was made to have improved the Papantoniou's composition by adding the oil soluble UV-B sunscreen compound 4-methylbenzlidene camphor because this compound has been previously taught for use in lipstick by Hansenne.

Therefore, the invention as a whole would have been prima facie obvious to a person of ordinary skill at the time the invention was made.

Claims 36, 37, 41, 42, 44, 45, 51, 53, 54, 64, and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,355,261 (Bonda, 2002).

Example III of Bonda (Col. 16) teaches a lipstick composition which comprises an oil phase castor oil present in an amount of 41% which is present

Art Unit: 1619

in a fatty phase. Vegetable waxes (Candellila and carnauba) are also present as an oil phase, comprising 7% of the composition by weight. The composition comprises a solid phase which contains pigments and a barium lake. The combined amount of the pigments are 3.0% of the composition. The composition also comprises mica. Bonda exemplifies use of methyl and propyl parabens in the lipstick of Example III. Bonda teaches that rosemary extract, methyl paraben, and propyl paraben are equivalent preservative agents. (Col. 12, lines 1-5). Bonda further teaches use of preservatives in an amount of 0.5% by weight (Classic lipstick, Col. 11, lines 25-40).

Bonda does not exemplify a composition comprising 0.5% rosemary extract.

A person of ordinary skill in the art would have had a reasonable expectation of success in substituting rosemary extract for both methyl and propyl paraben in the lipstick composition of Example III because Bonda teaches these three preservative agents as equivalents. The skilled artisan would have been motivated to do so because Bonda invites routine experimentation by teaching natural preservatives such as rosemary extract and citric acid as well as synthetic preservatives such as propyl paraben.

It therefore would have been obvious to a person of ordinary skill in the art at the time the invention was made to substitute rosemary extract for the for both methyl and propyl paraben in the lipstick composition of Example III because Bonda teaches that they are equivalents.

Art Unit: 1619

With regard to the of rosemary extract (i.e. preservative agent), a person of ordinary skill in the art would have had a reasonable expectation of success in optimizing the amount of rosemary extract used in the composition to be present in an amount of 0.5% because Bonda teaches that preservatives are present in lipstick in an amount of 0.5% by weight. The skilled artisan would have been motivated to do so based upon the explicit teaching of Bonda.

It therefore would have been obvious to a person of ordinary skill in the art at the time the invention was made to optimizing the amount of rosemary extract used in the composition to be present in an amount of 0.5%.

Therefore, the invention as a whole would have been prima facie obvious to a person of ordinary skill at the time the invention was made.

Claim 66 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bonda as applied to claims 36, 37, 41, 42, 44, 45, 51, 53, 54, 64, and 65 above, and further in view of US Patent No. 6,641,845 (Kogyo, 2003).

The teachings of Bonda are relied upon as above. Bonda teaches use of rosemary extract as a preserving agent in cosmetic compositions such as lipstick (Col. 12, lines 1-5).

Bonda does not teach whether this rosemary extract is an oil soluble dry extract.

Kogyo teaches a cosmetic composition which may comprise oil miscible rosemary extract powder. Kogyo teaches use of oil miscible rosemary extract

Art Unit: 1619

powder is preferable (Col. 3 lines 65 to end; Col.4, lines 1-10; Samples A and B, Col. 4).

A person of ordinary skill in the art would have had a reasonable expectation of success in substituting the rosemary extract in the composition taught by Bonda for the oil miscible rosemary extract powder taught by Kogyo because Kogyo teaches that oil miscible rosemary extract powder is preferable for cosmetic compositions. The skilled artisan would have been motivated to do so because Kogyo teaches use of oil miscible rosemary extract powder in cosmetic compositions and Bonda provides an invitation to optimize the composition by stating the at the preservative agents were not limited to those in which he specifically teaches (Col. 12, lines 1-5).

It therefore would have been obvious to a person of ordinary skill in the art at the time the invention was made to substitute the rosemary extract in the composition taught by Bonda for the oil miscible rosemary extract powder taught by Kogyo because Kogyo teaches that this form of rosemary extract is preferable for topical cosmetic compositions.

Therefore, the invention as a whole would have been *prima facie* obvious to a person of ordinary skill at the time the invention was made.

Claim 67 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bonda as applied to claims 36, 37, 41, 42, 44, 45, 51, 53, 54, 64, and 65 above, and further in view of US Patent No. 2,873,229 (Wick, 1959) and US Patent No. 2,708,631 (Neiman, 1955).

The teachings of Bonda are relied upon as above. Bonda teaches use of rosemary extract as a preserving agent in cosmetic compositions such as lipstick (Col. 12, lines 1-5). However, Bonda also teaches that preservatives are not limited to those he specifically teaches (Col. 12, lines 1-5).

Bonda does not teach use of vanillin in the lipstick composition.

Wick teaches a three phase lipstick composition (title). Use of vanillin as a flavoring agent is taught (Col. 4, lines 50-65).

Neiman teaches that vanillin has some preservative effect (Col. 3, lines 30-40)

A person of ordinary skill in the art would have had a reasonable expectation of success in improving the composition taught by Bonda by adding vanillin to the lipstick composition because vanillin is a flavoring agent used in lipstick as taught by Wick and vanillin is a preservative as taught by Neiman. The skilled artisan would have been motivated to do so because Bonda provides an invitation to optimize his composition by teaching that the preservative agents are not limited to those species in which he specifically recites.

It therefore would have been obvious to a person of ordinary skill in the art at the time the invention was made to improve the invention of Bonda by adding vanillin to the lipstick composition because vanillin is taught as a flavoring agent for use in lipstick which has a preservative effect by Wick and Neiman respectively.

Therefore, the invention as a whole would have been prima facie obvious to a person of ordinary skill at the time the invention was made.

Claims 36, 69 and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over UK Patent Application GB 2084084 (Morane, 1981).

Example III (page 4, lines 25-55) of Morane exemplifies a composition against rings under the eyes (i.e. a makeup). This composition comprises a vegetable oil phase comprising carnauba wax and a solid phase comprising of iron oxide. The composition is disclosed as being cased into a pencil corresponding to the Figure I which is the first embodiment. This first form (Embodiment 1) is a sheath made of plastic (page 1, lines 30-45). Morane teaches that the composition is cast right into the sleeve (page 1, lines 50-60), thus forming a lead. Morane is silent as to whether this form needs further processing or is available for immediate use. Morane also teaches a second process in which the "active products" are cast inside a thermoplastic sleeve, thus forming a lead. The molded core under goes further processing in that it is allowed to cool and harden, thus it is taught to be unavailable for immediate use (page 1, lines 50-60). **[Done]**

However, Morane does not exemplify a process in which the composition of Example III (made from the process of embodiment 1) undergoes further processing steps such as that of cooling and hardening.

A person of ordinary skill in the art would have had a reasonable expectation of success in optimizing the first process of embodiment 1 taught by Morane by adding a subsequent processing steps, i.e. the steps of hardening and cooling as taught by the second method of Morane to the method of

Art Unit: 1619

processes of embodiment 1. The skilled artisan would have been motivated to do so because Morane invites optimization of the processing method by teaching alternative embodiments and specifically teaching a method in which the plastic sleeve and cast active ingredients are able to undergo cooling and hardening steps. **[Done]**

It therefore would have been obvious to a person of ordinary skill in the art at the time the invention was made to add the additional processing steps of hardening and cooling to the process of embodiment 1 because Morane teaches the additional processing steps of hardening and cooling of the plastic sleeve containing the cast active agent.

Therefore, the invention as a whole would have been prima facie obvious to a person of ordinary skill at the time the invention was made.

Claims 36, 68, 73, 74, and 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,277,182 (Lebok, 2001).

Example III of Lebok teaches a lipliner (Col. 6, lines 1-25). The lipliner comprises a vegetable oil phase of castor oil and hydrogenated vegetable oil. A solid phase is also present. The composition comprises pigment. The lip liner material was cast into molds and cooked to produce shaped leads (i.e. stick). These leads were placed into the sleeve banks, glued, and further processed to produce a pencil. Lebok teaches that these sleeves may be wood or plastic (Col. 4, lines 30-40), thus they are equivalents. In a separate embodiment, Lebok teaches that casting in molds that are mounted on rotary

Art Unit: 1619

mechanisms, hence the preparation is directly cast into the rotary mechanism to form a pencil (Col.4, lines 60-end) (reading on instant claim 74).

Lebok does not exemplify casting the leads (i.e. stick) into wood.

A person of ordinary skill in the art would have had a reasonable expectation of success in modifying the composition taught by Lebok so that such that the composition comprises a stick (a lead) in wood because Lebok teaches a composition which comprises a stick (or lead) glued into sleeve banks which may be either wood or plastic. The skilled artisan would have been motivated to do so because Lebok extends an invitation to optimize the composition by selecting either wood or plastic.

It therefore would have been obvious to a person of ordinary skill in the art at the time the invention was made to select a sleeve of wood in which the lead could be placed and glued because Lebok teaches sleeve may be made of wood.

With regard to the method, a person of ordinary skill in the art would have had a reasonable expectation of success in casting the preparation into wood sleeves, gluing it and further processing it because Lebok teaches placing leads into the sleeve banks, which may be either wood or plastic, gluing them and further processing them to produce a pencil. The skilled artisan would have been motivated to do so because Lebok teaches that sleeve may be made out of either wood or plastic and extends the invitation to optimize.

It therefore would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the method taught by Lebok to

Art Unit: 1619

involve placing the lead (i.e. casting the lead) into the wooden sleeves because Lobek teaches that lead may be cast into either wood or plastic.

With regard to the method of casting the preparation into a rotary mechanism of a pencil to form a lead, a person of ordinary skill in the art would have had a reasonable expectation of success in casting preparation of Lebok into in molds that are mounted on rotary mechanisms to form a lead pencil because Lebok teaches a method in which a preparation is directly cast into the rotary mechanism to form a pencil. The skilled artisan would have been motivated to do so because Lebok extends an invitation to optimize the process by teaching that the preparation may be placed in sleeves and glued, or may be casting the preparation into directly into sleeves that have been placed into rotary mechanisms.

It therefore would have been obvious to a person of ordinary skill in the art at the time the invention was made to have cast the preparation into sleeves that have been place into a rotary mechanism to form a lead.

Therefore, the invention as a whole would have been prima facie obvious to a person of ordinary skill at the time the invention was made.

Claims 36 and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 4,437,895 (Koulbanis, 1984) in view of US Patent No. 2131046 (Hoffman, 1938).

The examiner notes that instant claim 71 includes product-by-process limitations. M.P.E.P. § 2113 reads, "Product-by-process claims are not limited to

Art Unit: 1619

the manipulations of the recited steps, only the structure implied by the steps."

The structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product. See, e.g., *In re Gamero*, 412 F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1979). In this case, all that is implied by the steps recited in claim 71 is that a paste be in a tube or a pot.

Once a product appearing to be substantially identical is found and an art rejection made, the burden shifts to the applicant to show an unobvious difference.

Example 10 of Koulbanis teaches a lipstick composition which comprises of a vegetable based oil phase and a pigment solid phase. (Col. 5 lines 60-end; Col. 6 lines 1-5).

Koulbanis does not teach that the lipstick is a paste nor does Koulbanis teach an applicator for the lipstick composition.

Hoffman teaches that lipstick is a pasty cosmetic (i.e. lipstick is a paste) which is packaged in carriers which provide support for the cosmetic (Col. 1 lines 1-5). Figures 1-7 demonstrate that the lipstick holder and its constituents are cylindrical or "tube" shaped.

A person of ordinary skill in the art would have had a reasonable expectation of success in adding the lipstick taught by Koulbanis to the tube shaped holder taught by Hoffman because Hoffman teaches that his holder is for

Art Unit: 1619

lipstick. The skilled artisan would have been motivated to do so in order to have the lipstick composition supported, as taught by Hoffman.

It therefore would have been obvious to a person of ordinary skill in the art at the time the invention was made to add the pastyl lipstick composition taught by Koulbanis into the holder taught by Hoffman in order to support the lipstick.

Therefore, the invention as a whole would have been prima facie obvious to a person of ordinary skill at the time the invention was made.

Claims 36-38, 51-53, 56, 57 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koulbanis in view of US Patent No. 2131046 (Hoffman, 1938) and Japanese Patent No. 406181813 (Okada, 1994).

The examiner notes that instant claim 70 includes product-by-process limitations. The discussion of product-by-process limitations in the above rejection of claim 71 over Koulbanis and Davis also applies to claim 70.

Example 10 of Koulbanis teaches a lipstick composition which comprises a vegetable based oil phase and a pigment solid phase (Col. 5 lines 60-end; Col. 6 lines 1-5).

Koulbanis does not teach that the lipstick composition is a paste nor does Koulbanis teach that the composition was placed in the form of a stick into a rotary spindle mechanism of a pencil.

Hoffman teaches that lipstick is a pasty cosmetic (i.e. lipstick is a paste) which is packaged in carriers which provide support for the cosmetic (Col. 1 lines 1-5).

Okada teaches a lipstick storage container (paragraph 19 of the English translation). Paragraph 21 discloses that the lipstick moves up and down to a rotation impotientia. The lipstick moves up and down within the cylinder when the screw stick is engaged. Okada further teaches that it is easy to use. With regard to the lipstick storage container being a pencil, it is meant to be easy to use (paragraph 23) in the use of the lipstick. Thus, the lipstick holder is a pencil since it enables the "drawing on" of lipstick.

A person of ordinary skill in the art would have had a reasonable expectation of success in improving the lipstick composition by Koulbanis by placing it in the lipstick holder of Okada because Okada teaches that his container is a lipstick holder. The skilled artisan would have been motivated to do so because Hoffman teaches that lipstick is a pasty cosmetic which are supported by lipstick holders/containers and Okada teaches that his lipstick container is good look and easy to use.

It therefore would have been obvious to a person of ordinary skill in the art at the time the invention was made to improve Koulbanis's lipstick composition by placing it in Okada good looking and easy to use lipstick holder.

Therefore, the invention as a whole would have been prima facie obvious to a person of ordinary skill at the time the invention was made.

Claims 36, 37, 40-42, 44, 45, 51, 54, 55 and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Papantoniou in view of US Patent No. 2,190,844 (Mills, 1940).

The examiner notes that instant claim 72 includes product-by-process limitations. The discussion of product-by-process limitations in the above rejection of claim 70 over Koulbanis and Davis also applies to claim 72.

Once a product appearing to be substantially identical is found and an art rejection made, the burden shifts to the applicant to show an unobvious difference.

Example III (Col 10, lines 30-55) of Papantoniou discloses a lip polish (i.e. make up). This lip polish comprises a lipid component (Fatty composition C). Fatty composition C comprises the vegetable oil phases of candellila wax, carnauba wax, and ricin oil (Col 10, lines 30-55); these reagents comprise 1.9%, 1.9%, and 37% by weight, of the composition respectively. Thus the content of the vegetable oils is 37% (reading on instant claims 41, 44) and the content of the of the vegetable waxes is 3.8%. The composition comprises a solid phase which comprises the aluminum lake of the organic pigment FD&C Yellow No.5. and Zirconium lake of the organic pigment D and C red No 21. The solid phase comprises 2% of the composition by weight. Papantoniou teaches that the lip polish is in a form of a paste (Col. 6 lines 21-25).

Papantoniou does not teach packaging the composition into a bowl of metal.

Mills teaches a metal container (title) for storing viscous compositions such as cosmetics (Col.1 lines 40-50). The inner shell is cup shaped (i.e. bowl shaped) and may be formed by a single sheet of metal (Col. 2, lines 1-20).

A person of ordinary skill in the art would have had a reasonable expectation of success in improving the paste lip polish of Papantoniou by packaging it in the metal container of Mills because Mills teaches that his metal bowls are specifically for storing viscous cosmetic compositions. The skilled artisan would have been motivated to do so because Papantoniou's lip polish is viscous cosmetic (i.e. a paste).

It therefore would have been obvious to a person of ordinary skill in the art at the time the invention was made to package the Papantoniou's paste lip polish composition in the metal bowl of Mills because Mills' metal bowl is specifically for storing cosmetics.

Therefore, the invention as a whole would have been prima facie obvious to a person of ordinary skill at the time the invention was made.

Response to Arguments

Applicant's arguments filed 09/08/2008 have been fully considered but they are not persuasive. Applicant submits that closure of the claim language in claim 36 to "consists of" limits the constituents of the oil phase to only vegetable sources. Applicant submits that this claim language overcomes the prior art rejections.

The examiner disagrees. Instant claim 36 **comprises** a lipid bearing preparation. This lipid preparation **comprises** an oil phase and a solid phase. The term "comprising" is open claim language which permits additional oil phases (which may comprise of material other than a mixture of vegetable based

Art Unit: 1619

materials) to be present. Additionally, non-vegetable based materials may be present in the lipid bearing preparation. See M.P.E.P. § 2111.03 for a discussion of the breadth of various transitional phrases.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LORI MATTISON whose telephone number is (571)270-5866. The examiner can normally be reached on 8am-6pm (Monday-Thursday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571)272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/L. M./
Examiner, Art Unit 1619

/Lora E Barnhart/
Primary Examiner, Art Unit 1651